

**REMARKS**

The Office Action dated February 17, 2009 has been received and carefully noted. The above amendments to the drawings and specification, and the following remarks, are submitted as a full and complete response thereto.

Claims 1-16 are currently pending and are respectfully submitted for consideration.

Reconsideration and withdrawal of the objections and rejections is respectfully requested in light of the following remarks.

**Response to Restriction Requirement**

In the Office Action, an acknowledgement was made of the Applicants election of claims 1-3, 5-8, 11, and 14. However, it was stated in the Office Action that claims 7, 8, 11, and 14 have been withdrawn from consideration. Specifically, in the Office Action, it was found that claims 7, 8, and 11 were allegedly directed to Figures 11 and 12, which illustrate a constant velocity joint comprising a gap H. In the Office Action, it was also found that claim 14 is allegedly directed to Figure 17, which illustrates a constant velocity joint comprising a retaining member mounted in an annular groove. Therefore, according to the Office Action, claims 7, 8, 11, and 14 are allegedly directed to non-elected species.

Since the Office set forth a new restriction requirement by further withdrawing claims 7, 8, 11, and 14 from the pending claims, Applicants respectfully traverse this restriction requirement. Specifically, Applicants respectfully submit that the Office has not set forth an appropriate explanation to indicate that there would be a serious burden on the Examiner if a restriction is not required. There are two criteria for a proper requirement for restriction between patentably distinct inventions: (a) the inventions must be independent; and (b) there would be a serious burden on the examiner if restriction is not required. See MPEP § 803.

In order for the Examiner to prove that there is a serious burden, the Examiner must show by appropriate explanation of one of the following:

**(A) Separate classification thereof:** This shows that each invention has attained recognition in the art as a separate subject for inventive effort, and also a separate field of search. Patents need not be cited to show separate classification.

**(B) A separate status in the art when they are classifiable together:** Even though they are classified together, each invention can be shown to have formed a separate subject for inventive effort when the examiner can show a recognition of separate inventive effort by inventors. Separate status in the art may be shown by citing patents which are evidence of such separate status, and also of a separate field of search.

**(C) A different field of search:** Where it is necessary to search for one of the inventions in a manner that is not likely to result in finding art pertinent to the other invention(s) (e.g., searching different classes/subclasses or electronic resources, or employing different search queries), a different field of search is shown, even though the two are classified together. The indicated different field of search must in fact be pertinent to the type of subject matter covered by the claims. Patents need not be cited to show different fields of search.

See MPEP § 808.02 In the present case, the Office has neither shown nor provided an appropriate explanation of one of the above-mentioned reasons to establish that the Examiner would be faced with a serious burden if the restriction requirement is not required. Therefore, Applicants respectfully request that the restriction requirement be withdrawn and claims 1-16 be considered.

### **Objections to the Drawings**

The drawings filed on December 24, 2008 were objected to because the legends in figures 20 and 21 were not oriented in the same direction as the figures themselves. Applicants note that the MPEP and the CFR do not explicitly require that a legend (e.g. prior art) in a figure be oriented in the same direction as the drawing. However, Applicants have amended the Figures to correct the orientation of the legends to further advance prosecution of this application. Accordingly, withdrawal of the objection is respectfully requested.

### **Objections to the Specification**

The specification was objected to because at page 16, line 8, the word “inner” should have been “outer”. The correction is submitted herewith. Accordingly, withdrawal of the objection is respectfully requested.

## **Rejections under 35 U.S.C. § 112**

Claim 3 was rejected under 35 U.S.C. §112, first paragraph, for allegedly failing to comply with the enablement requirement. In particular, in the Office Action, it was asserted that the limitation “a gap (X) is set between said annular member and said rolling elements for providing a predetermined distance ( $\delta$ ) by which said roller is movable in an axial direction of said trunnion” of claim 3 was not described in the specification in such a way as to enable a person of ordinary skill in the art to make and/or use the invention. However, Applicants respectfully traverse this rejection as follows.

Applicants respectfully submit that the Office has failed to make a *prima facie* case for lack of enablement under the first paragraph of 35 U.S.C. § 112. In particular, the Office failed to set forth any of the factors to be considered when determining whether there is sufficient evidence to support a determination that a disclosure does not satisfy the enablement requirement and whether any necessary experimentation is “undue”. See MPEP § 2164.01(a). These factors include, but are not limited to:

- (A) The breadth of the claims;
- (B) The nature of the invention;
- (C) The state of the prior art;
- (D) The level of one of ordinary skill;
- (E) The level of predictability in the art;
- (F) The amount of direction provided by the inventor;
- (G) The existence of working examples; and
- (H) The quantity of experimentation needed to make or use the invention based on the content of the disclosure.

See MPEP § 2164.01(a). The examiner's analysis must consider all the evidence related to each of these factors, and any conclusion of nonenablement must be based on the evidence as a whole. See MPEP § 2164.01(a), citing 858 F.2d at 737, 740, 8 USPQ2d at 1404, 1407. Since the Office Action does not mention any of the above factors, Applicants respectfully submit that the Office has failed to establish that the disclosure is not enabling.

Furthermore, the features recited in claim 3 is fully enabled by page 20, line 11 to page 21, line 25 of the specification. For example, the Specification indicates that each of the rollers 48, which are mounted on the trunnion 44 about which the angle of the tilt is defined, are moved inwardly by a distance  $\delta$ . See Specification, page 21, lines 7-9. This distance  $\delta$  is expressed as  $b \cdot \tan 30^\circ = R/2 \cdot (1/\cos\theta - 1)$ . See Specification, page 21, lines 9-12. Based on the above result, a gap X is designed to be a minimum gap between the needle bearing roller 46 and the annular member 50. See Specification, page 21, lines 13-18.

Stated another way, a gap X is set between said annular member and said rolling elements to provide a predetermined distance ( $\delta$ ) by which said roller is movable in an axial direction of said trunnion. Therefore, Applicants respectfully submit that the disclosure of the pending application is fully enabling.

Accordingly, Applicants respectfully request that the rejection of claim 3 be withdrawn for at least the reasons presented above.

Claims 3 and 6 were rejected under 35 U.S.C. §112, second paragraph, for being indefinite for failing to particularly point out and distinctly claim the subject matter which Applicants regard as the invention.

Regarding claim 3, it was asserted in the Office Action that it was unclear how the gap X in claim 3 corresponds to the gap X disclosed in the specification, since the disclosed gap X also includes the gap between the flange and the rolling elements. However, Applicants respectfully traverse this rejection as follows.

As mentioned above, page 21, lines 13-15 of the Specification describes that a gap K (corresponding to the gap X) is between the needle bearing roller 46 and the annular member 50, 54. Claim 3 recites, in part, “a gap (X) is set between said annular member and said rolling elements”. Therefore, Applicants respectfully request that the rejection of claim 3 be withdrawn for at least the reasons presented above.

Regarding claim 6, in the Office Action, it was stated that claim 6 recites the limitation “ $\theta_{max}$ ”. Specifically, it was asserted in the Office Action that it was not clear how the angle is definitely defined, as the angle is arbitrarily set based on the situational circumstances that vary from one user to another. However, Applicants respectfully traverse this rejection as follows.

Applicants respectfully submit that page 21, lines 20-25 of the Specification describes that the  $\theta_{max}$  represents the maximum angle of tilt of the inner member 34. In other words, the angle of the title of the inner member 34 cannot go beyond  $\theta_{max}$ .

Because the angle of the title of the inner member 34 cannot go beyond  $\theta_{max}$ , a desired angle  $\theta$  of tilt can be achieved. Therefore,  $\theta_{max}$  cannot be an arbitrary angle, but a maximum angle so a desired angle  $\theta$  can be achieved.

Accordingly, Applicants respectfully request that the Examiner withdraw the rejection of claim 6 for at least the reasons presented above.

### **Rejections under 35 U.S.C. § 102**

Claims 1-3 and 6 were rejected under 35 U.S.C. § 102(b) as being anticipated by Mazziotti (U.S. Patent No. 3,008,311). The Office Action asserted that Mazziotti discloses all of the elements recited in claims 1-3 and 6. However, this rejection is respectfully traversed as follows.

Claim 1, upon which claims 2, 3, 5 and 6, are dependent, recites a constant-velocity joint having a tubular outer member having a plurality of axially extending guide grooves defined in an inner circumferential surface thereof and spaced at predetermined intervals. The outer member is connected to one transmission shaft. An inner member is inserted in an open internal space of the outer member and connected to another transmission shaft. The inner member includes a plurality of trunnions projecting into the guide grooves. The inner member includes a ring-shaped roller held in contact with each of the guide grooves and fitted over each of the trunnions. The inner member includes a plurality of rolling elements rollingly interposed between each of the trunnions and the

roller. The roller having a flange disposed on an inner circumferential surface thereof near a projecting end of each of the trunnions. The flange projecting radially inwardly and circularly extending along the inner circumferential surface. An annular member is mounted on the trunnion near a proximal end thereof. The rolling elements being retained between the flange and the annular member.

As will be discussed below, Applicants respectfully submit that Mazziotti fails to disclose, either expressly or inherently, all of the elements of the claims, and therefore fails to provide the advantages and features discussed above.

Mazziotti generally discusses a universal joint that permits relative axial displacement between the torque transmitting shafts. See Mazziotti, column 1, lines 8-11. It was asserted in the Office Action that the Mazziotti discloses that “an annular member is mounted on said trunnion near a proximal end thereof”, as recited in claim 1.

However, a review of Mazziotti reveals that Mazziotti does not disclose, either expressly or inherently, “an annular member is mounted on said trunnion near a proximal end thereof”, as recited in claim 1. Instead, Figure 2 of Mazziotti illustrates that each inner surface 44 seats a caged annulus of roller bearings 48 (e.g. the alleged annular member). See Mazziotti, column 2, lines 43-44. The roller bearings 48 engages the base 50 of the bearing sleeve 52 (e.g. the alleged ring shape roller). See Mazziotti, column 2, lines 44-45.

In other words, Figure 2 of Mazziotti illustrates that the rolling bearings 48 are connected to the bearing sleeves 52 and not to the trunnion 42, as alleged in the Office Action. Therefore, Mazziotti cannot disclose, either expressly or inherently, “an annular member...mounted on said trunnion”, as recited in claim 1.

Furthermore, because rolling bearings 48 in Mazziotti are mounted to the bearing sleeves 52, Mazziotti cannot disclose, either expressly or inherently, that “[the] rolling elements [are] retained between [the] flange and [the] annular member”, as recited in claim 1. Instead, the annulus of the needle bearings 56 (e.g. the alleged rolling elements) are retained between the annular lip 54 of the bearing sleeves 52 and the outer abutment surface 46 of the trunnions 42.

Therefore, a person of ordinary skilled in the art cannot construe the disclosure of Mazziotti to provide an annulus of the needle bearings 56 (e.g. the alleged rolling elements) to be retained between the rolling bearings 48 and the annular lip 54 of the bearing sleeves 52. Accordingly, Mazziotti does not disclose, either expressly or inherently, at least, “[the] rolling elements being retained between [the] flange and [the] annular member”, as recited in claim 1.

Because claims 2, 3, 5, and 6 depend upon claim 1, Applicants respectfully submit that claims 2, 3, 5, and 6 inherit the patentable features thereof. As such, Applicants respectfully request that the rejection of claims 2, 3, 5, and 6 be withdrawn for at least the

same and/or similar reasons as base claim 1, and for the specific limitations recited therein.

Claims 1-3, 5, and 6 were rejected under 35 U.S.C. § 102(e) as being anticipated by Kawakatsu et al. (U.S. Patent Publication No. 2006/0211502). Specifically, it was asserted in the Office Action that Kawakatsu et al. discloses all of the elements recited in claims 1-3, 5, and 6. However, this rejection is respectfully traversed as follows.

Applicants respectfully submit that this rejection is improper, as Kawakatsu et al. does not afford a § 102(e) priority date. In order for Kawakatsu et al. to obtain a § 102(e), the international application (PCT application no. PCT/JP04/03627) of Kawakatsu et al. needs to be filed in English and designate the U.S. See MPEP § 706.02(f)(1). In this case, the international application of Kawakatsu et al. was not filed in English but filed in Japanese. See corresponding PCT application at the WIPO website - <http://www.wipo.int/pctdb/en/>. Because the international application of Kawakatsu et al was filed in Japanese, Kawakatsu et al. cannot be used as prior art because this reference does not meet the requirements under 35 U.S.C. § 102(e).

Attached hereto is an English translation of the certified priority documents of Japanese application no. 2004-057137. The submission of the English translation of the certified priority documents of Japanese application no. 2004-057137 antedates Kawakatsu et al.

Since the priority date for the present application is March 2, 2004, and U.S. Patent Publication No. 2006/0211502 of Kawakatsu et al. was not published until September 21, 2006, Kawakatsu et al. also clearly fails to qualify as prior art under 35 U.S.C. §§ 102(a) or (b). Furthermore, because the pending application's priority date (e.g. March 2, 2004) is before the publication date (e.g. March 18, 2008) of the international application of Kawakatsu et al., the international application of Kawakatsu et al. cannot be relied upon as prior art under any section of §§ 102 or 103.

Accordingly, Applicants respectfully request that the rejection of claims 1-3, 5, and 6 be withdrawn and these claims be allowed for at least the reasons stated above.

### **Conclusion**

For at least the reasons discussed above, Applicants respectfully submit that none of the cited references, whether considered alone or in combination, disclose, either expressly, implicitly or inherently, all of the elements of the claimed invention. These distinctions are more than sufficient to render the claimed invention unanticipated and unobvious. It is therefore respectfully requested that all of claims 1-16 be allowed, and this application passed to issue.

If for any reason the Examiner determines that the application is not now in condition for allowance, it is respectfully requested that the Examiner contact, by

telephone, the applicants' undersigned attorney at the indicated telephone number to arrange for an interview to expedite the disposition of this application.

In the event this paper is not being timely filed, the applicants respectfully petition for an appropriate extension of time. Any fees for such an extension together with any additional fees may be charged to Counsel's Deposit Account 50-2222.

Respectfully submitted,



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Enclosures: Translation of JP2004-057137  
Replacement Sheets